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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,391	07/19/2000	Roman Schertler	622/40901C2	2663

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EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 05/06/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/619,391

Applicant(s)

SCHERTLER, ROMAN

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-43, 45-54 and 72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35, 37-43 and 45-51 is/are allowed.
- 6) ☒ Claim(s) 36, 52-54 and 72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/3/03 has been entered.

Response to Amendment

2. Applicant please note that it is unnecessary to submit claims not being currently amended in reissue practice. Only current amendments should be submitted, and the interim 37 CFR 1.121 amendment practice does not apply to reissue applications.

Supplemental Declaration

3. In view of the amendments filed 4/3/03, a supplemental declaration complying with 37 CFR 1.175(b) is required in response to this office action.

Recapture

4. **Claims 52-54** are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d

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1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In claim 52, line 5 of the instant reissue application, "projecting from" has been deleted. This is an improper recapture of broadened subject matter because applicant surrendered the "projecting from" limitation in the parent case.

In the parent case, claims 8 and 9 were put in independent form in combination with the limitations of claim 1. Claim 8 included the limitations "projecting from". Because applicant intentionally put the limitations of both claim 8 and 9 in combination with independent claim 1, applicant surrendered the subject matter of claims 8 and 9. Applicant essentially amended the claims to place the claims in condition for allowance. The examiner in the parent case indicated that claim 9 included allowable subject matter and that if applicant put the limitations therein in independent form including all of the limitations of the base claim and any intervening claims, the case would be allowed. Since applicant also included the limitations of claim 8 into independent form, the limitations therein were also surrendered.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 36, 53, and 72** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 36 and 53 recite “normals on said opening areas being rectangularly arranged with respect to said rotational axis”. It is unclear what “rectangularly arranged” encompasses. If the “rectangularly arranged” limitation means that the apparatus is configured as shown in fig. 9 of applicant’s invention, then the depiction shown in fig. 9 of applicant’s invention does not have a “radial component relative to said drive shaft” as recited in the independent claims 35 and 52 and the scope of the claims is unclear.

Claim 72 recites “A method for manufacturing” which should be - - A method for processing - -. The workpiece being worked on is not being manufactured or made, but rather is being processed or worked on.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claim 72** is rejected under 35 U.S.C. 103(a) as being unpatentable over Helms (4,813,846) in view of Lorenz et al. (5,135,349).

Helms teaches a method for manufacturing at least two workpieces, comprising the steps of providing a vacuum chamber **35** with two openings **36,39** defining respective opening areas, providing a transport device **7a** having a drive shaft rotatable around a rotational axis of the drive shaft, providing a conveyor **10** for at least one disk shaped workpiece (col. 1, line 55, "wafers" are disk shaped), and providing a transport arm **7b** for each conveyor **10** and projecting from the drive shaft, applying a disk shaped workpiece upon the support plane of the conveyor **10**, providing a treating station **36-41**, rotating the transport device **7a** and therewith the workpieces by 180 degrees so as to align each of the workpieces with one of the openings **36-41**, moving the conveyor **10** with the workpieces by the respective arm **7b** towards the two openings **36-41** and treating one of the two workpieces on the support plane of the conveyor **10** at one of the openings by the treatment chamber **36-41**.

Helms teaches the invention cited above with the exception of having two conveyors, a transport arm for each conveyor mounted opposite each other and projecting from the drive shaft.

Lorenz et al. teach two conveyors (below **S1,S2**), a transport arm **W1,W2** for each conveyor mounted opposite each other and projecting from the drive shaft **14**.

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It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Helms with two conveyors, a transport arm for each conveyor mounted opposite each other and projecting from the drive shaft, in light of the teachings of Lorenz et al., in order to provide more flexibility in wafer transport (col. 4, lines 5-15 as suggested by Lorenz et al.).

Allowable Subject Matter

9. **Claims 35, 37-43 and 45-51** are allowed.

10. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 35, 37-43 and 45-51, the prior art of record does not teach or suggest a vacuum process apparatus for processing at least one workpiece, comprising a chamber with two conveyors defining a support plane, and a transport arm for each conveyor mounted opposite each other and projecting from the drive shaft, wherein the support plane is perpendicular to the radial component in combination with all of the other claim limitations.

It is noted that Shertler teaches transport arms **24** that do not project from the drive shaft, whereas the claimed invention requires that the transport arms project from the drive shaft.

Toshimasa, Helms, and Lorenz et al. teach transport arms which project from drive shafts, however, the conveyors therein have support planes which are on the same plane as the radial components of the arms, whereas the instant invention requires that the support plane is perpendicular to the radial component of the arms.

It is noted that Shertler teaches arms **24** with components **52,54**. However, the

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components are not radial components relative to the drive shaft. It is understood that the claimed radial component is represented in applicant's fig. 2-4 and 6-8 drawings. Fig. 9 of applicant's drawings does not depict the claimed invention because the radial components **v** of the arms **23** are not radial components relative to the drive shaft.

Response to Arguments

11. Applicant's arguments filed 4/3/03 have been fully considered but they are not persuasive.

12. Applicant argues that Helms does not teach that the disk shaped workpieces are to remain on the conveyors. However, the claims do not require that the workpieces remain on the conveyors. It is also noted that Lorenz et al. suggests that the workpieces **S1** could remain on the conveyors **W1**. Claim 72 requires "moving the conveyors with the workpieces by said respective arms towards said tow openings and treating one of said two workpieces on **said support plane**". It is noted that "said support plane" is not a physical element of the apparatus, but rather an imaginary reference or imaginary plane. It is noted that the "plane" of Helms and Lorenz et al. could be considered an infinitely large plane on the surface of the conveyors **10** (see Helms). Therefore, even if the conveyor of Helms is removed from the stations **36-41**, the workpiece is still on the same "plane" as the conveyor surface. Therefore, the limitation "each defining a support plane" is not a physical limitation because it does not have structure. It is an imaginary plane on a Cartesian coordinate system.

Contact Information

13. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is **703-306-5965**. The examiner can normally be reached on **Monday-Friday, between 5:30 am- 2:00 pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

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April 30, 2003


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TECHNOLOGY CENTER 3700